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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,330	03/10/2005	Stephen Edward Lummes	123119	3513

25944 7590 02/09/2007  
OLIFF & BERRIDGE, PLC  
P.O. BOX 19928  
ALEXANDRIA, VA 22320

EXAMINER
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GUADALUPE, YARITZA

ART UNIT	PAPER NUMBER
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2859

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/09/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/527,330

Applicant(s)

LUMMES ET AL.

Examiner

Yaritza Guadalupe-McCall

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 October 2007 and 30 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

In response to Amendment filed October 12, 2006

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 – 5, 7 and 13 are rejected under 35 U.S.C. 102 ( b ) as being anticipated by Spivey et al. ( US 5,212,872 ).

In regards to claim 1, Spivey et al. discloses a touch probe ( 6, 8 ) comprising a probe body ( 14, 68 as stated in columns 2 and 3, line 39 and lines 45 – 46 respectively ) housing first locating elements ( 34, 38, 48, 50, 52 ); a stylus holder ( 10 ) having second locating elements (28, 30 ) which cooperates with the first locating elements to locate the stylus holder within the probe body ( See Column 3, lines 8 – 22 ); and a bias ( 34 which causes an axial force acting on the shaft as described in column 3, lines 15 – 20 ) to urge the first and second locating elements into contact, wherein a damping element ( 94, 96, 97 ) is provided to damp motion between the probe body and the stylus holder ( See Column 4, lines 3 – 15 ).

Regarding claim 2, Spivey et al. also disclose a touch probe wherein the damping element ( 94, 96, 97 ) slows a relative movement between the first and second locating elements.

With respect to claim 3, Spivey et al. further shows a touch probe wherein the damping element ( 94, 96, 97 ) slows the relative movement by resisting the urging of the bias.

Regarding claim 4, Spivey et al. disclose a touch probe wherein the damping element is slidably mounted with respect to the stylus holder ( 10 ).

In regards to claim 5, Spivey et al. teach a touch probe wherein the damping element is slidably mounted with respect to both the probe and the stylus holder.

With respect to claim 7, Spivey et al. disclose a touch probe wherein the damping element absorbs energy produced by a relative movement between the probe body and stylus holder.

With regards to claim 13, Spivey et al. shows a touch probe wherein the first locating element ( 34, 38, 48, 50, 52 ) each comprise a ball and the second locating element comprise a V – shaped groove ( 28, 30 ) which partially hoses the ball and is supported thereon (See Figure 2).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 8 - 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Spivey et al. (US 5,212,872 ).

Spivey et al. discloses a touch probe as stated in paragraph 4 above.

Spivey et al. do not disclose the particular lossy material as stated in claims 8 – 10 and the particular amount of material used as stated in claim 11. Spivey et al. does not disclose the particular first locating members including a pair of balls forming a V – shaped seat as stated in claim 12.

Regarding the material used as stated in claims 8 - 10 : Spivey et al. discloses a touch probe having an element but does not disclose the particular material used . The particular type of material used to make the element, absent any criticality, is only considered to be the use of a “ preferred ” or “ optimum ” material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to

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provide using routine experimentation based, among other things, on the intended use of Applicant's apparatus, i.e., suitability for the intended use of Applicant's apparatus. See In re Leshin, 125 USPQ 416 (CCPA 1960 ) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious.

In regards to the amount of material or concentration of material used as stated in claim 11 : To make an element between 10 and 120 pph of carbon powder, is only considered to be the "optimum" value of the concentration or amount of material for the element, as stated above, that a person having ordinary skill in the art at the time the invention was made would have been able to determine using routine experimentation based, among other things, on the desired accuracy and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. See In re Boesch, 205 USPQ 215 ( CCPA 1980 ).

With respect to claim 12 : Spivey et al. discloses a touch probe having a first locating element having a ball ( 38 ) and a second locating element comprising a V – groove housing the ball. The use of the particular type of first and second locating elements as claimed by applicant, i.e., pair of balls forming a V – shaped seat and a roller, absent any criticality, is considered to be nothing more than a choice of engineering skill, choice or design because 1) neither non-obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art, will be obtained as long as the probe body and the stylus holder are structurally connected, as already suggested by Spivey et al. 2) the first and second locating elements claimed by Applicant and the first and second locating elements used by Spivey et al. are well

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known alternate types of first and second locating elements which will perform the same function, if one is replaced with the other, of structurally connecting the probe body and the stylus holder, and 3) the use of the particular type of first and second locating elements by Applicant are considered to be nothing more than the use of one of numerous and well known alternate types of first and second locating elements that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to structurally connect the probe body and the stylus holder as already suggested by Spivey et al.

### *Response to Arguments*

5. Applicant's arguments with respect to claims 1 - 13 have been considered but are moot in view of the new ground(s) of rejection given by the new interpretation of the Spivey et al. reference.

Applicant arguments regarding the Spivey reference not showing a probe body housing as referenced by numerals ( 14, 68 ) are not persuasive. The Spivey clearly describes these elements ( 14, 68 ) as a probe cylindrical housing ( 14 ) and probe body ( 68 ), which together form the structure of the probe ( 10, column 2, lines 38 – 40 ) and shank ( 12 ) as shown in Figures 2 and 3.

Applicant's arguments regarding the Spivey reference not including any kind of damping element is not persuasive. The Spivey reference explicitly describes a damping mechanism ( See Column 4, lines 3 – 9 ), including a spring ( 92 ) in order to damp any vibration between the shank and probe body, therefore, clearly teaching the presence of a damping element and anticipating the claimed language.

### *Conclusion*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yaritza Guadalupe McCall whose telephone number is (571) 272-2244. The examiner can normally be reached on 9:00 AM - 6:30 PM.

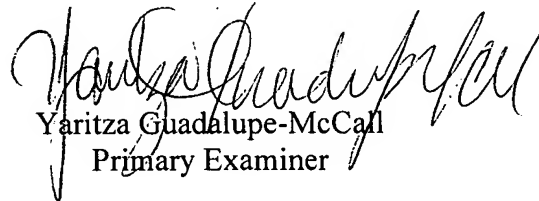
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YGM  
February 5, 2007  
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Yaritza Guadalupe-McCall  
Primary Examiner